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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,167	07/11/2000	THIERRY GICQUEL	72211/9011	6758

7590 01/23/2002  
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EXAMINER

PADMANABHAN, KARTIC

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 01/23/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/554,167

Applicant(s)

GICQUEL ET AL.

Examiner

Kartic Padmanabhan

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 3, 2002 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 4-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitations "the form of a vessel" in line 2, "the intensity" in line 5, and "the reaction mixture" in lines 5-6. There is insufficient antecedent basis for these limitations in the claim.

5. Claim 5 recites the limitations "the results" in lines 6-7, "the intensity" in line 9, "the form" in line 10, "the reaction mixture" in lines 13-14. There is insufficient antecedent basis for these limitations in the claim.

6. Claim 9 recites the limitation "the electrical values" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1641

7. Claim 11 recites the limitations "the results" in lines 6-7, "the intensity" in line 9, "the form" in line 10, "the reaction mixture" in lines 13-14, and "the outside" in line 17. There is insufficient antecedent basis for these limitations in the claim. In addition, applicant should replace "test" with "assay" in line 19 to maintain consistent terminology. Applicant should also change "detect" to "detects" in the last line of the claim.

8. Claim 12 is rejected as vague and indefinite because it is unclear if the claim is intended to depend on claim 14, or if it should depend on another claim.

9. Claim 13 recites the limitations "the light" in line 2, "the presence" in line 3, "the light intensity" in line 4, "the form" in line 5, and "the reaction mixture" in lines 8-9. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 1641

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1, 4-10, and 12-15 are *still* rejected under 35 U.S.C. 103(a) as being unpatentable over Uzan et al. (US Pat. 5,849,247) in view of Berthold et al. (US Pat. 5,048,957), Smethers et al. (US Pat. 5,643,535), and Honzawa et al. (US Pat. 5,637,874).

Uzan et al. teaches an automatic immunological assay comprising reaction wells, means for supporting samples to be analyzed, means for supporting reagents, means for taking determined quantities of samples and of reagents and depositing them in reaction wells, means for reading assay results, and means for displacing the wells (col. 1). The reference also teaches means for washing or rinsing the beads in the vessels (col. 2). Furthermore, the reaction modules are formed as single pieces by molding plastics, each comprising eight reaction wells (col. 3). In addition, the reference also teaches the use of a pivoting arm that is used to position reagents or samples (col. 5). A substrate specific to a specific enzyme in the reaction well is deposited in the well, and enzyme interaction takes place, which is followed by reading of the results (col. 7). Uzan et al. also teach horizontal plates for receiving or supporting the washing means and photometric means. The reference does not teach the specific use of vessels with opaque sides, a chemiluminescent substance as the enzyme in the reaction well, a shutter mechanism, or a light proof shoe.

Berthold et al. teach a specimen rack made of radiopaque material, such that each cuvette, except for a region defined by the lower opening cross section of the through chambers

Art Unit: 1641

and their upper filling opening, is continuously shielded from scattering radiation from adjacent cuvettes (abstract). The reference does not teach the use of a chemiluminescent substance, a shutter, or a light proof shoe.

Smethers et al. teach a luminometer with reduced sample crosstalk comprising an array of sample wells, a photodetector assembly, and means for moving the sample tray and photodetector (abstract). Each well in the array has a structure defining a window through which light can be emitted (col. 2). The reference also teaches the use of luminescence, either chemiluminescence or bioluminescence, as an effective for the determination of a variety of analytes (col. 1). Smethers et al. also teach a photodetector internal-calibration system. This includes a sealed chamber with a light source contained therein, a photosensor, and means for directing the light emitted from the light source to the photodetector when the assembly is positioned at an internal calibration system station. In addition, the reference teaches an external calibration system (col. 2). The reference does not teach the use of a shutter or lightproof shoe.

Honzawa et al. teach a chemiluminescence measuring apparatus comprising a shutter mechanism. The shutter mechanism, when closed, will create a temporary dark chamber that is proof against external light, at which time the photodetector will measure the luminescence. Furthermore, the shutter mechanism includes a rotating hollow chamber, which houses the vessel, a dark box, which can be interpreted as a light-proof shoe, that encompasses the read window, and a photosensing unit, which includes a photomultiplier (col. 2). The rotation of the cylindrical member determines when the shutter opens and closes, and correspondingly when the luminescence is measured. In addition, the dark box portion of the lightproof shoe has an opening that creates an optical path between the vessel and photometric means (col. 2).

Art Unit: 1641

It would have been *prima facie* obvious to one of ordinary skill at the time of the invention to use the opaque vessel of Berthold et al. and the chemiluminescent label of Smethers et al. with the vessel of Uzan et al. One would have been motivated to use a chemiluminescent label with the vessel of Uzan et al. because they teach the generic use an enzyme specific for a substrate that produces a detectable signal. Chemiluminescent labels are widely used for this purpose, and would have been an obvious choice for use in the vessel. In addition, one would have been motivated to use a vessel or well with opaque sides to reduce the cross talk or contamination of reading between cells. Since opaque sides limit the emission of light to the top-filling opening, other wells will not be contaminated with the results of adjacent wells.

It would have further been *prima facie* obvious to one of ordinary skill at the time of the invention to use the shutter mechanism and light-proof shoe of Honzawa et al. with the modified vessel of Uzan et al. One would have been motivated to use the shutter mechanism to create a temporary dark chamber to obtain a luminescence reading. Furthermore, a shutter mechanism is well known in the art, as the majority of commercially available photometry instruments utilize these mechanisms to take luminescence readings. In addition, a lightproof shoe can be interpreted as any enclosure or part that is impermeable to light. Once again, this is well known in the art, as all photometers utilize this technique. It would have been obvious to use the calibration system of Smethers et al. with the modified device of Uzan et al. in order to ensure accurate readings for the samples. Calibration is also well known in the art, as background readings need to be subtracted to get true luminescence readings.

***Allowable Subject Matter***

14. Claim 11 is allowable over the prior art of record.

Art Unit: 1641

15. Claim 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

16. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art of record do not disclose or teach an apparatus, wherein a light source illuminates the outside of a dark chamber to test the apparatus for light tightness. Therefore, claim 11 is novel and unobvious over the art of record.

***Conclusion***

Claims 1 and 4-15 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan  
Patent Examiner  
Art Unit 1641

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164  
January 14, 2002

*Christopher L. Chin*  
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PRIMARY EXAMINER  
GROUP 1800-1641